



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/746,817	12/22/2000	Steven K. Lee	2062	8898

7590

10/08/2003

Daniel A. Tysver  
Beck & Tysver  
Suite 440  
1011 First Street South  
Hopkins, MN 55343

EXAMINER

BROWN, RUEBEN M

ART UNIT

PAPER NUMBER

2611

DATE MAILED: 10/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/746,817

Applicant(s)

LEE, STEVEN K.

Examiner

Reuben M. Brown

Art Unit

2611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☐ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-21, 23-35 & 38-46 are rejected under 35 U.S.C. 102(e) as being anticipated by Throckmorton, (U.S. Pat # 5,818,441).

Considering claim 1, the claimed method of presenting a commercial message with a desired digital signal comprising combining the commercial message with the desired digital signal into a combined digital stream is met by Throckmorton, Fig. 2 & col. 4, lines 35-50, which discloses a data sequencer 14 that combines a primary data stream and an associated data stream.

The claimed commercial message reads on the associated data and the claimed desired digital signal reads on the primary data stream, since Throckmorton teaches that the video may be in digital form, col. 4, lines 38-41.

Art Unit: 2611

As for the additionally claimed feature of transmitting the combined data stream over a wireless network, Thockmorton teaches that connecting media could be wireless, col 4, lines 50-52.

The further claimed feature of decoding the combined commercial message and desired digital signal and presenting the same to the end user is met by col. 6, lines 50-58 & col. 7, lines 21-30.

Considering claim 2, the elements disclosed in Fig. 2 of Throckmorton, the claimed local area network reads on the primary data stream subsystem 10, associated data stream subsystem 16, data synchronizer 20, sequencer 14 encoder 26 & transmitter 30.

Considering claims 3-6, Thockmorton teaches that the various links and media may comprise different transmission algorithms, including the Internet; see col. 2, lines 64-67; col. 4, lines 1-20; col. 4, lines 45-55; col. 5, lines 65-67; col. 6, lines 21-28.

Considering claims 7-9, see Throckmorton col. 6, lines 6-20 & col. 6, lines 35-50.

Considering claims 10 & 33-34, Throckmorton teaches embedding associated data in the VBI, col. 5, lines 48-64.

Considering claim 11; see col. 3, lines 59-61, which teaches that the primary data stream

Art Unit: 2611

can stand on its own, with/without the enhancements of the associated data stream.

Considering claims 12-15 & 35, Throckmorton discloses transmitting the combined data stream over a digital data network, col. 8, lines 21-24, which utilizes MPEG format.

Considering claim 16, Throckmorton teaches that the primary video data and the associated data may be transmitted separately and combined at a user's receiving device, col. 4, lines 5-20.

Considering claim 17, Throckmorton discloses transmission of data over the Internet, col. 8, lines 52-67.

Considering claims 18-20, see Throckmorton col. 3, lines 42-48.

Considering claim 21, the claimed elements of a wireless network corresponds with subject matter mentioned above in the analysis of claim 1, and is likewise treated.

Considering claim 23, see Fig. 3 & col. 6, lines 4-15.

Considering claim 24, Throckmorton teaches that the receiver 36, may be an adapter, col. 6, lines 7-10.

Art Unit: 2611

Considering claims 25-26, see col. 4, lines 15-20 & col. 8, lines 20-64.

Considering claim 27, Throckmorton teaches storage of commercial data messages at the receiver 36, col. 7, line 67 thru col. 8, lines 1-15.

Considering claims 28-31, Throckmorton teaches that the primary stream may be video data, which may be received from broadcasters; see col. 3, lines 35-52.

Considering claim 32, see col. 6, lines 38-41.

Considering claim 38, the claimed elements of an adapter for receiving a commercial message combined with a desired digital signal is met by the disclosure of the elements of the cable box discussed in Throckmorton, col. 6, lines 8-15.

Considering claim 39, Throckmorton teaches that the receiver 36 may receive a range of different formatted signals, col. 6, lines 1-20.

Considering claims 40-41, see col. 7, lines 21-30.

Considering claim 42, Throckmorton teaches a user selecting content, col. 4, lines 25-32 & col. 7, lines 15-20.

Art Unit: 2611

Considering claim 43, see col. 3, lines 10-15; col. 4, lines 25-27; col. 6, lines 21-28 & col. 7, line 67.

Considering claims 44-45, see Throckmorton col. 7, lines 21-50.

Considering claim 46, see col. 6, lines 8-15.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 22 & 36-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Throckmorton.

Considering claim 22, Throckmorton does not explicitly disclose that the all of the components of the data stream creation unit are enclosed in one unit. Examiner takes note that at the time the invention was made, it was known in the art to include video combining hardware within a single device. It would have been obvious for one of ordinary skill in the art

Art Unit: 2611

at the time the invention was made, to operate Throckmorton in a manner wherein the plurality of content combining elements are included in one physical container, at least for the desirable advantage of eliminating the need for local network transmission means.

Considering claim 36, Throckmorton does not explicitly disclose the spectrum of the broadband channels. It would have been obvious to utilize channel bandwidth of any particular range for the benefit of most efficiently utilizing available bandwidth.

Considering claim 37, Throckmorton does not explicitly discuss the claimed feature of channel selection. Examiner takes note that at the time the invention was made handshaking techniques for locating an available channel was well known in the art. It would have been obvious for one of ordinary skill in the art at the time the invention was made, to operate Throckmorton, to locate an available channel at least for the known benefit of avoiding interferences.

### *Conclusion*

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

A) Kikinis Teaches combining commercial messages with a video program in digital format.



Art Unit: 2611

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**or faxed to:**

(703) 872-9306, (for formal communications intended for entry)

**Or:**

(703) 746-6861 (for informal or draft communications, please label  
"PROPOSED" or "DRAFT")


*Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,  
Arlington, VA., Sixth Floor (Receptionist).*

Any inquiry concerning this communication or earlier communications from the  
examiner should be directed to Reuben M. Brown whose telephone number is (703) 305-2399.  
The examiner can normally be reached on M-F (8:30-6:00), First Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's  
supervisor, Andrew I. Faile can be reached on (703) 305-4380. The fax phone numbers for the  
organization where this application or proceeding is assigned is (703) 872-9306 for regular  
communications and After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding  
should be directed to the receptionist whose telephone number is (703) 305-4700.

Reuben M. Brown

  
ANDREW FAILE  
SUPERVISORY  
TELEPHONE NUMBER